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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Keith D. ALLEN

Group Art Unit: 1632

Serial No.: 09/903,377

Examiner: Paras Jr., Peter

Filed: July 10, 2001

Attorney Docket No.: R-365

For: TRANSGENIC MICE CONTAINING CHEMOKINE RECEPTOR 9A GENE
DISRUPTIONS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

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In response to the Office communication mailed October 3, 2002, concerning the Examiner's restriction of the claims, Applicant hereby provisionally elects, with traverse, Group III (claims 8, 10, and 17-22), drawn to a non-human transgenic animal comprising a disruption in a chemokine receptor 9A gene and a method of making the same.

In the restriction, the Examiner asserts that claims 1-30 are drawn to ten distinct subjects, grouped as: Invention I (claims 1-4), drawn to a targeting construct homologous to the chemokine receptor 9A gene and methods of producing the targeting construct; Invention II (claims 5-7 and 9), drawn to cells comprising a disruption in a chemokine receptor 9A gene; Invention III (claims 8, 10 and 17-22), drawn to a non-human transgenic animal, particularly a mouse, comprising a disruption in a chemokine receptor 9A gene, and a method of producing the same; Invention IV (claims 11, 12 and 24), drawn to methods of identifying agents that modulate the expression of a chemokine receptor 9A gene or function of a chemokine receptor 9A by screening the agent in non-human transgenic animals; Invention V (claims 13-15 and 26-27), drawn to methods of identifying agents that modulate the expression of a chemokine receptor 9A gene or function of a chemokine receptor 9A in a cell *in vitro*; Invention VI (claim 16), drawn to agents that modulate the expression of a chemokine receptor 9A or function of a chemokine

receptor 9A; Invention VII (claim 30), drawn to phenotypic data associated with a transgenic mouse, in a database; Invention VIII (claim 28), drawn to agents associated with chemokine receptor 9A gene disruptions, expression, function or behaviors; Invention IX (claims 23 and 25), drawn to methods of identifying an agent that modulates a phenotype associated with or behavior associated with a disruption in a chemokine receptor 9A gene, comprising screening agents in a transgenic mouse; and Invention X (claim 29), drawn to an agonist or antagonist of a chemokine receptor 9A. Applicant respectfully requests reconsideration and withdrawal of the requirement.

The Examiner asserts that the products of Inventions I, II, III, VI, VII, VIII and X are unrelated, each from the other, because the different inventions have different modes of operation, different functions and different effects, and are thus patentably distinct inventions. The Applicant disagrees with the Examiner's assertion in that the claims of Inventions I, II, III, VI, VII, VIII and X are related to one another. Therefore, a separate search or examination would not unduly burden the Examiner.

The Examiner further asserts that the claims of Inventions IV, V and IX are patentably distinct inventions, having distinct purpose, distinct methodologies and distinct products. The Applicant disagrees with the Examiner's conclusion in that the claims of Invention IV, V and IX are related to one another, and therefore a separate search or examination that would seriously burden the Examiner would not be required.

The Examiner also asserts that the products of Inventions I, II, III, VI, VII, VIII and X are patentably distinct from the claims of Inventions IV, V and IX, as the inventions have different modes of operation, different function and different effects from the other. The Applicant disagrees with the Examiner's conclusion, in that the claims of Inventions I, II, III, VI, VII, VIII and X and the claims of Inventions IV, V and IX are related. A separate search or examination on these claims can be made without serious burden to the Examiner.

Although Applicant has provisionally elected Group III for purposes of advancing prosecution of the present application, Applicant contends, for the foregoing reasons, that the restriction requirement is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement.

A petition for the Extension of Time for the response to the Office Action for a period of three months from December 3, 2002 up to and including February 3, 2003 is submitted concurrently herewith.

Respectfully submitted,

Date: February 3, 2003

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Enclosures